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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,793	10/27/2003	Eugene M. Lee	113708.129US1	1059
23400	7590	09/02/2011	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2177	
			NOTIFICATION DATE	DELIVERY MODE
			09/02/2011	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* EUGENE M. LEE and DIETMAR C. MAY

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Appeal 2009-014745  
Application 10/692,793  
Technology Center 2100

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Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-3, 6-10, 13-18, 20-28, and 54. Claims 4, 5, 11, 12, and 19 have been cancelled, and claims 29-53 have been withdrawn from consideration. Br. 4. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

## STATEMENT OF THE CASE

Appellants' invention annotates and links documents and data in an intellectual property management system. *See generally* Abstract. Claim 1 is illustrative with key disputed limitations emphasized:

1 A computer-implemented system for providing annotated electronic documents, the annotations which are to be applied to the documents being stored in a first data storage, the documents being stored in a second data storage, the first data storage and the second data storage being at least one of physically separate and logically separate, said system comprising:

(A) an annotation component configured to determine, responsive to at least one user, at least one annotation to be applied to at least one document, including a selection resource to select at least a portion of the at least one document and to associate the at least one annotation therewith, and a mark-up resource to at least one of add and edit the at least one annotation, wherein the annotation is image data or text, wherein each annotation can be different from every other annotation;

(B) a reference component, responsive to the at least one user, configured to at least one of establish, traverse, indicate, and remove, at least one reference between the at least one portion and at least one of an other portion of the at least one document, an other document, and at least one other portion of the other document; and

(C) at least one *merge component* configured:  
to retrieve the at least one document from the first data storage as document data,  
to retrieve the at least one annotation to be applied to said at least one document from a second data storage as annotation data, and

*to combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the annotation embedded seamlessly in the document data.*

The Examiner relies on the following as evidence of unpatentability:

Eintracht	US 6,687,878 B1	Feb. 3, 2004 (filed Mar. 15, 1999)
Rivette	US 6,877,137 B1	Apr. 5, 2005 (filed Dec. 7, 1999)

#### THE REJECTION

The Examiner rejected claims 1-3, 6-10, 13-18, 20-28, and 54 under 35 U.S.C. § 103(a) as unpatentable over Rivette and Eintracht. Ans. 4-30.<sup>1</sup>

#### CONTENTIONS

Regarding representative claim 1, the Examiner finds that Rivette's electronic document annotation system has every recited feature except for the recited "merge component," but cites Eintracht for this feature in concluding that the claim would have been obvious. Ans. 4-10, 30-39.

Appellants argue that the cited prior art does not teach or suggest a merge component that combines retrieved document and annotation data to form a unitary, single logical document that displays annotations seamlessly embedded in the document data as claimed. Br. 11-16. According to Appellants, Eintracht layers seamed annotation documents on the document data, but does not form a single, unitary logical document, let alone display annotations embedded seamlessly in the document data. *Id.*

Appellants add that the cited prior art fails to disclose a "split component" that (1) extracts annotation and document data from a single

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<sup>1</sup> Throughout this opinion, we refer to the Appeal Brief filed December 5, 2008 and the Examiner's Answer mailed March 4, 2009.

logical document, and (2) updates a document from the extracted document data as recited in claim 18. The issues before us, then, are as follows:

### ISSUES

Under § 103, has the Examiner erred by finding that Rivette and Eintracht collectively would have taught or suggested:

(1) a merge component that combines retrieved document and annotation data to form a unitary, single logical document that displays annotations embedded seamlessly in the document data as recited in claim 1?

(2) a split component that (a) extracts annotation and document data from a single logical document; (b) updates at least one annotation in a first data storage from the extracted annotation data; and (c) updates at least one document in a second data storage from the extracted document data as recited in claim 18?

### FINDINGS OF FACT (FF)

1. The Examiner's factual findings regarding Rivette's disclosure (Ans. 4-7, 10-11, 30-31, 33-34, 39) are undisputed. *See generally* Br. 11-20.

2. Eintracht's system enables collaborative document annotation by exchanging notes (i.e., annotations)<sup>2</sup> attached to web-based documents. Eintracht, col. 1, ll. 8-13; col. 2, ll. 8-15; col. 5, ll. 62-63; col. 7, ll. 55-58; Fig. 3.

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<sup>2</sup> Eintracht refers to annotations and notes interchangeably and synonymously. Eintracht, col. 7, ll. 57-59.

3. Annotations are portions of text or graphical drawings associated with a specific document location. An annotation can be (1) displayed within its own window, or (2) layered on top of the displayed document. Eintracht, col. 5, ll. 62-63; col. 7, ll. 55-58; col. 7, l. 66 – col. 8, l. 3.

4. Eintracht's Figure 1B shows a display 10 with a single document window 14 displaying an image with annotations 16. The annotations are displayed over the image, but are not part of the image itself. Eintracht's annotated image in Figure 1B is reproduced below:

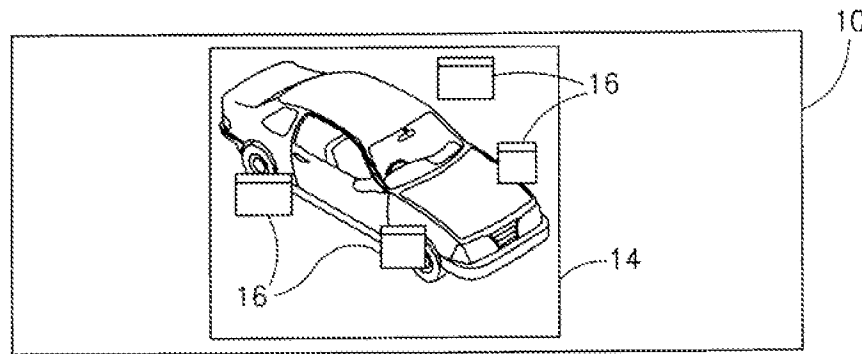


FIG.1B

**Eintracht's annotated image in Figure 1B**

5. Documents and associated annotations are treated independently from each other via separate data structures. Annotations are transmitted between client and server applications independent of the transmitted data related to the viewed document. The client software application layers the annotations over the image (or document) according to their coordinates to display the overlying annotations in a web browser window (e.g., similar to that shown in Figure 1B). The client application (1) displays the document the user wants to annotate, and (2) enables the user to create, edit, retrieve, and store notes. The client application can be a web browser plug-in 44

containing the user interface for document navigation and handling notes. Eintracht, col. 2, ll. 33-55; col. 8, ll. 5-31; col. 13, l. 35 – col. 14, l. 41; Figs. 3, 6 (steps 120-24, 132-36).

6. The Client Annotation Event and Server Annotation Response Data Structure includes (1) note color fields 220, 272 representing the color (i.e., a RGB value) that notes are to be displayed in, and (2) note shape fields 226, 278 that can specify various shapes including no shape. Eintracht, col. 17, ll. 10-53; col. 18, l. 15 – col. 19, l. 9; Figs. 10-13.

## ANALYSIS

### *Claims 1-3, 6, 8-10, 13-17, and 25-28*

We begin by noting that Appellants do not dispute the Examiner's reliance on Rivette regarding representative claim 1. FF 1. Nor do Appellants dispute the references' combinability. Rather, Appellants dispute the Examiner's reliance on Eintracht for teaching the recited "merge component." We therefore confine our discussion to Eintracht.

On this record, we see no error in the Examiner's reliance on Eintracht for at least suggesting combining retrieved document and annotation data to form a unitary, single logical document that displays annotations embedded seamlessly in the document data as claimed. To be sure, Eintracht layers annotations over displayed documents such that the annotations are visibly distinct from the underlying document or image. FF 3-4. And Eintracht treats documents and associated annotations independently of each other via separate data structures. FF 5. But nothing in the claim precludes the functionality of the client web browser plug-in that at least suggests combining received annotation and document data into

a single document (e.g., an HTML document) that is rendered for display in the browser. *See* FF 3-5.

Although Eintracht layers the annotations over the image to partly cover the underlying image as in Figure 1B (FF 4-5), achieving this display by rendering an associated document (e.g., an HTML document) that combines annotation and document data would have been obvious, particularly since both types of data are simultaneously displayed in a web browser. *See id.*

While the annotations are rendered as boxes with visible borders for display (FF 4), they are nonetheless embedded seamlessly in the document (image) data at least to the extent that the document and annotations appear to the user as a single image, despite originating from different data sources. *See* FF 3-5. Appellants' contention that the annotations' visible borders constitute seams and therefore are not embedded seamlessly in the document data (Br. 13-14) is unavailing and, in any event, is not commensurate with the scope of the claim.

But even if we were to assume that these borders somehow constitute seams as Appellants contend, they need not be so displayed, for they can be rendered in a variety of selectable colors and shapes—even no shape at all. *See* FF 6. Skilled artisans would recognize that the annotations' color and shape (or lack thereof) could be selected to match that of the underlying image or document to more seamlessly blend with the image or document. Such creative applications of this display functionality for a desired visual presentation are well within the level of ordinarily skilled artisans. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).



We are therefore not persuaded that the Examiner erred in rejecting representative claim 1, and claims 2, 3, 6, 8-10, 13-17, and 25-28 not separately argued with particularity.

*Claims 7, 18, 20-24, and 54*

We do not, however, sustain the Examiner's rejection of independent claim 18 which recites, in pertinent part, a "split component" that (1) extracts annotation and document data from a single logical document; (2) updates at least one annotation in a first data storage from the extracted annotation data; and (3) updates at least one document in a second data storage from the extracted document data.

Although Eintracht effectively extracts annotation and document data from the single logical document (e.g., HTML document) to respectively display the respective document (image) and annotations in the browser, we fail to see how documents stored separately from the annotations would be updated *from the extracted document data* as claimed as Appellants indicate (Br. 17-19). Although clients can edit and update annotations (FF 2, 5) in Eintracht, that does not mean that they can update the underlying documents, let alone update them from the extracted document data as claimed. Nor does the Examiner's reliance on Rivette (Ans. 39-42) cure this deficiency.

We are therefore persuaded that the Examiner erred in rejecting (1) independent claim 18; (2) dependent claims 20-24 and 54<sup>3</sup> for similar

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<sup>3</sup> Since our decision reversing the Examiner's rejection of independent claim 18 is dispositive, we need not reach Appellants' other arguments regarding dependent claim 54 (Br. 19-20). We note, however, that the Examiner's incorporation of the cited Microsoft Word for Windows Users Guide by

reasons; and (3) claim 7 which recites commensurate limitations.

### CONCLUSION

Under § 103, the Examiner did not err in rejecting claims 1-3, 6, 8-10, 13-17, and 25-28, but erred in rejecting claims 7, 18, 20-24, and 54.

### ORDER

The Examiner's decision rejecting claims 1-3, 6-10, 13-18, 20-28, and 54 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

### AFFIRMED-IN-PART

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reference in its entirety in the Examiner's rejection must made of record as Appellants indicate (Br. 19). *See* MPEP 707.05(a); *see also* MPEP § 2144.03(C) (noting that Examiners must provide documentary evidence to substantiate assertions of Official Notice if traversed).